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In re Application of
SATO, et al.
U.S. Application No.: 10/534,807
PCT No.: PCT/IB03/05107
Int. Filing Date: 10 November 2003
Priority Date: 12 November 2002
Attorney Docket No.: US 020443
For: METHOD AND APPARATUS FOR EFFICIENT
TIMEOUT MESSAGE MANAGEMENT

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the applicant's "Declaration of Facts Regarding Inventor's Unavailability" filed 12 May 2005 in the United States Patent and Trademark Office (USPTO). The declaration and accompanying papers are being treated as a petition under 37 CFR 1.47(a) to accept the application without the signature of co-inventor Kazunobu Toguchi.

BACKGROUND

On 10 November 2003, applicant filed international application PCT/IB03/05107 which claimed priority to an earlier application filed 12 November 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 May 2005.

On 12 May 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee; an Information Disclosure Statement; an assignment for recording and the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventor Kazunobu Toguchi.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items (1) and (4) above. It is noted that although the papers are being treated as a petition under 37 CFR 1.47(a), they appear to be a copy of papers filed with the RO/IB in the international application.

Regarding item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Presently, applicant provided a statement from counsel that Koninklijke Philips Electronics, N.V. and his assistant, Ms. Edna Chapa have attempted to contact Mr. Toguchi and provide him with the relevant materials. However, it appears that after the return of the first mailing on October 27, 2003 applicant knew that Mr. Toguchi no longer lives at the McKinley address in White Plains. As such, the silence of Mr. Toguchi cannot be considered a refusal to execute the declaration as he never received the papers. Therefore, in order to proceed in the National stage in the United States applicant must present evidence that it has made a diligent effort to locate Mr. Toguchi. As shown above, applicant must provide information as to "diligent effort" such as whether a search of telephone directories or Internet search engines were performed in an attempt to find a current address for Mr. Toguchi.

In light of the above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** **without prejudice**.

As authorized, the \$200.00 petition fee will be charged to deposit account No. 14-1270

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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